



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,465	04/24/2001	Seth Haberman	0813808.12502	5373
22832	7590	10/07/2010		
K&L Gates LLP STATE STREET FINANCIAL CENTER One Lincoln Street BOSTON, MA 02111-2950			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT	PAPER NUMBER
			2424	
			MAIL DATE	DELIVERY MODE
			10/07/2010 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/841,465

**Applicant(s)**

HABERMAN ET AL.

**Examiner**

MICHAEL VAN HANDEL

**Art Unit**

2424

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/20/2010 has been entered.

#### ***Response to Amendment***

2. This action is responsive to an Amendment filed 7/20/2010. Claims **1-19** are pending. Claims **1, 16, and 19** are amended. Claims **20, 21** are canceled.

#### ***Response to Arguments***

3. Applicant's arguments regarding claims **1, 16, and 19**, filed 7/20/2010, have been fully considered, but they are not persuasive.

Regarding claims **1, 16, and 19**, the applicant argues that the combination of Ficco and Klosterman et al. does not teach that the advertisement template have a plurality of media slots in sequence and each of the media slots receiving one of a plurality of media segments. The examiner respectfully disagrees. Ficco discloses taking a prescheduled advertisement and replacing at least a portion of the advertisement with an ad segment more directly targeting a viewer, such as an ad for a local General Motors dealer (p. 6, paragraph 84). The examiner

interprets the original advertisement slot to be an advertisement template and the parts of the original advertisement slot that have segments inserted into them to be media slots in sequence, as currently claimed. Ficco further discloses that a variety of ad segments are stored on the set-top box and dynamically replaced or otherwise synchronized with the remainder of the broadcast (p. 1, paragraph 9). The ad selector selects one or more of the ad segments from the ad segment memory for insertion into the original ad (p. 3, paragraph 44). If the ad segment has a length less than the time segment corresponding to the originally broadcast advertisement, the ad segment can be replaced at a variable time within the time slot (p. 3, paragraph 47). This meets the limitation of “presenting a personalized advertisement template comprising a plurality of media slots in sequence, each of the media slots receiving one of a plurality of media segments,” as currently claimed, because the first portion of the ad contains the original ad video segment and the second portion of the ad contains the inserted ad segment. Furthermore, Ficco discloses that if the length of the adapted ad is less than the time slot assigned to the originally broadcast ad, the remaining time slot must be filled. This fill-in process may be performed by selecting another advertisement or by repeating the adapted advertisement until the time slot is filled (p. 5, paragraph 75). This also meets the limitation, because an ad segment is selected for a slot and if there is time remaining in the original ad time slot, another ad segment is selected or the ad segment is repeated until the original broadcast ad time slot is filled.

Further regarding claims **1**, **16**, and **19**, the applicant argues that the combination of Ficco and Klosterman et al. does not teach using content selection information to switch between said plurality of data streams to retrieve and insert at least one of said media segments into each of said media slots and assembling at the receiving unit a customized broadcast transmission stream

as the personalized advertisement. The examiner respectfully disagrees. Ficco discloses that the ad segments have a type, content, category, or other selection criteria associated with them that allows the multiplexer to select the ad segment most appropriate to a particular ad selection factor (p. 2, paragraph 36). Ficco discloses that the ad segments can also have a time value stored within them so that the multiplexer can synchronize the ad segment within the originally broadcast advertisement (p. 3, paragraph 47). As such, the examiner maintains that the combination of Ficco and Klosterman et al. teaches using content selection information to switch between said plurality of data streams to retrieve and insert at least one of said media segments into each of said media slots and assembling at the receiving unit a customized broadcast transmission stream as the personalized advertisement, as currently claimed.

### ***Claim Objections***

4. Claims **1-15** are objected to because of the following informalities:

Referring to claim **1**, the examiner notes that the phrase “each of the media slots receiving one of a plurality of media segments a portion of a personalized advertisement” is confusing. The examiner recommends that the phrase be changed to “each of the media slots receiving one of a plurality of media segments *that is* a portion of a personalized advertisement” (italicized for emphasis of change) and interprets the claim in the Office Action below as though the recommended changes have been made.

Claims **2-15** are objected to as being dependent on claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1-5, 8, 9, 12, 13, 15, 16, 18, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al.

Referring to claims **1, 13, 16, and 19**, Ficco discloses a method/system for allowing the creation of a plurality of personalized advertisements to be viewed by an intended audience (see Abstract), comprising:

- presenting a personalized advertisement template (originally broadcast advertisement slot) comprising a plurality of media slots in sequence (portions of original slot in which different media can be inserted)(p. 3, paragraph 47 & p. 5, paragraph 75), each of the media slots receiving one of a plurality of media segments that is a portion of a personalized advertisement (p. 1, paragraph 9; p. 2, paragraphs 23, 28, 35; p. 3, paragraph 47; & p. 5, paragraph 75), each of the plurality of different media segments comprising one of: an audio segment (p. 4, paragraph 55), a video segment (p. 4, paragraphs 60, 61), a graphics segment (p. 4, paragraphs 58-59), a rendering segment (p. 4, paragraphs 54, 57), and a segment of last minute information (p. 4, paragraph 60);
- transmitting a plurality of data streams to a receiving unit, each data stream delivering a different one of said plurality of media segments for said at least one of said slots

- (p. 2, 3, paragraphs 36-38), wherein said media segments are synchronized to begin and end at substantially the same time (p. 3, paragraphs 45-47; p. 5, paragraphs 63-65, 75); and
- transmitting content selection information regarding content of said plurality of data streams to said receiving unit, said information including switch times for said plurality of synchronized media segments, using said content selection information to switch between said plurality of data streams to retrieve and insert at least one of said media segments into each of said media slots, assembling at the receiving unit a customized broadcast transmission stream as said personalized advertisement (p. 2, paragraph 36; p. 3, paragraphs 45, 47; p. 5, paragraphs 63, 72, 75).

Ficco further discloses replacing an entire originally broadcast advertisement with a selected ad segment (p. 3, paragraph 46). Ficco does not specifically disclose that the plurality of data streams are transmitted simultaneously. Klosterman et al. discloses systems and methods for substituting alternative video and/or audio signals and/or graphics and/or text to be displayed on a viewer's television display monitor for the video and/or audio signals that would otherwise be displayed according to the channel to which the viewer has tuned the television set (see Abstract). Klosterman et al. further discloses providing alternative advertisements on separate simultaneously broadcast television channels, so that the receiver can tune between the different channels to receive content best suited for a particular viewer (p. 2, paragraphs 31, 32; p. 4, paragraphs 44-46). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the ad segment transmission of Ficco to be simultaneously

transmitted on alternate channels with the original broadcast, such as that taught in the video substitution system of Klosterman et al. in order to save storage space.

Referring to claim **2**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit selects among said plurality of data streams in real time (on-the-fly)(Ficco p. 1, paragraph 7).

Referring to claim **3**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said personalized advertisement is viewed by a viewer as it is assembled (adapted on-the-fly as it is being broadcast)(Ficco p. 1, paragraphs 7, 9, 13; p. 2, paragraph 27; & p. 3, paragraphs 46, 47).

Referring to claim **4**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit selects among said plurality of data streams based on said content selection information and information about a viewer who will view said personalized advertisement (Ficco p. 1, paragraphs 11, 12; p. 2, paragraph 26; p. 3, paragraphs 39, 40, 45-47; p. 4, paragraphs 58, 59; & p. 6, paragraphs 85-89).

Referring to claim **5**, the combination of Ficco and Klosterman et al. teaches the method of claim 4, further including providing a data stream with a default personalized advertisement to allow said receiving unit to display said default personalized advertisement without selecting between said plurality of data streams (Ficco p. 3, paragraph 46; p. 5, paragraphs 71-74; & Fig. 5).

Referring to claim **8**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said segments are incomplete parts of said personalized advertisement (Ficco p. 1, paragraph 9 & p. 3, paragraph 47).



Referring to claim **9**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, wherein said receiving unit is a set top box (Ficco p. 1, paragraph 8).

Referring to claims **12** and **18**, the combination of Ficco and Klosterman et al. teaches the method/system of claims 9 and 16, respectively, wherein said set top box momentarily switches from a first digital data stream to a second digital data stream to play out said personalized advertisement (Ficco p. 5, paragraph 75).

Referring to claim **15**, the combination of Ficco and Klosterman et al. teaches the method of claim 1, further including a plurality of templates for creating said personalized advertisements, wherein said templates include video sequence templates and audio sequence templates (Ficco p. 4, paragraph 62).

7. Claim **6** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Ten Kate et al.

Referring to claim **6**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. Klosterman et al. does not disclose that the plurality of data streams are MPEG encoded data streams. Ten Kate et al. discloses encoding video streams in MPEG-2 (col. 3, l. 39-41, 61-67). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be MPEG encoded, such as that taught by Ten Kate et al. in order to achieve a higher compression rate.

8. Claims **7, 10, 11, 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Picco et al.

Referring to claim **7**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. The combination of Ficco and Klosterman et al. does not specifically teach that the plurality of data streams are multiplexed into a transport stream. Picco et al. discloses multiplexing live television feeds 106, local content streams 108 and various other signals into a digital data stream that is then transmitted to a user (col. 8, l. 56-67 & Fig. 5). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be multiplexed into a digital data stream, such as that taught by Picco et al. in order to provide individualized local content in a digital stream by transmitting to the user a single multiplexed data stream (Picco et al. col. 2, l. 42-44).

Referring to claims **10, 11, and 17**, the combination of Ficco and Klosterman et al. teaches the method/system of claims 9 and 16. The combination of Ficco and Klosterman et al. further teaches that the invention can receive analog television and digital television (Ficco p. 2, 3, paragraphs 37, 38). The combination of Ficco and Klosterman et al. still further discloses switching advertisements in response to a channel change command in the vertical blanking interval (VBI)(Ficco p. 2, 3, paragraphs 36, 37 & Klosterman et al. p. 3, paragraph 38). The combination of Ficco and Klosterman et al. does not specifically teach that the set top box momentarily switches from an analog data stream to a digital data stream to play out said personalized advertisement triggered by VBI data. Picco et al. discloses a set top box 120 (Fig. 7) that can receive both analog data streams and digital data streams (col. 14, l. 62-67). Picco et

al. further discloses that the set top box 120 activates a web browser in response to a user selection when the user sees a television advertisement, which references a particular web site (col. 14, l. 17-41 & Fig. 11). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the VBI triggered advertisement switching of Klosterman et al. to include switching from an analog stream to a digital stream to display advertising information, such as that taught by Picco et al. in order to provide a television viewer with advertising from the Internet.

9. Claim **14** is rejected under 35 U.S.C. 103(a) as being unpatentable over Ficco in view of Klosterman et al. and further in view of Kunkel et al.

Referring to claim **14**, the combination of Ficco and Klosterman et al. teaches the method of claim 1. The combination of Ficco and Klosterman et al. does not specifically teach including transition segments, which are inserted into a personalized advertisement between segments. Kunkel et al. discloses encoding video streams in MPEG1 or MPEG2. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the transmission channels in the combination of Ficco and Klosterman et al. to be MPEG encoded, such as that taught by Kunkel et al. in order to achieve a higher compression rate. Kunkel et al. further discloses sending I-frames continuously at the beginning of targeted ads, so that the set top box tuners can quickly acquire the signal. Similarly, a continuous stream of I-frames is provided for the last few seconds of the advertisement to enable the tuners to quickly reacquire the original channel once the advertisement has concluded (p. 4, paragraph 31). It would have been obvious one of ordinary skill in the art at the time that the invention was made to modify

the combination of Klosterman et al. and Kunkel et al. to include continuously sending I-frames at the beginning and end of advertisements, such as that taught by Kunkel et al. in order to facilitate seamless transitions between advertisements and original programming (Kunkel et al. p. 4, paragraph 31).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL VAN HANDEL whose telephone number is (571)272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Van Handel/  
Primary Examiner, Art Unit 2424

Application/Control Number: 09/841,465

Page 12

Art Unit: 2424

9/30/2010